

REMARKS

Initially, Applicants have amended claims 188, 190, 199, 254, 285-287, 294-301, 303-304, and 306 to more accurately claim the present invention and not for any reason related to patentability. No new matter has been added. Applicants believe that the following comments will convince the Examiner that the rejections set forth in the January 3, 2003 Office Action have been overcome and should be withdrawn.

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I. THE INVENTION

Generally, the present invention is a system for accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a printed travel ticket comprising at least one machine recognizable feature, which may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. In the present invention, a machine recognizable feature is scanned or sensed, and converted into an electronic signal, which is transmitted for processing. In response to the electronic signal, programming material related to the printed travel ticket is displayed. Importantly, the present invention is designed to allow a

user (e.g., a traveler) to access programming material related to the user's travel.

II. THE EXAMINER'S REJECTIONS

5 A. DOUBLE PATENTING

The Examiner rejected claims 168, 301, and 304 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,932,863 (hereinafter referred to as "the '863 10 patent").

"Although the scope of claims 168, 301 and 304 of the present application and claim 1 of [the] '863 patent are almost identical, the difference between the present claimed invention and the 15 '863 patent is that the present claimed invention is a broader recitation of the '863 patent."

(January 3, 2003 Office Action Summary, p. 3, paragraph 2).

20 B. 35 U.S.C. § 103

The Examiner rejected claims 168-178, 181-183, 200-201, 225, 272-275, 280-282, 285, 296, 301, and 303-306 under 35 U.S.C. § 103(a) as being unpatentable over Withnall et al. U.S. Patent No. 4,488,035 (hereinafter

referred to as "Withnall") in view of Fields U.S. Patent No. 4,481,412 (hereinafter referred to as "Fields"). The Examiner opined that Withnall discloses a system that includes a feature recognition device that reads at least 5 one machine recognizable feature printed on a travel ticket to display travel information on the display of a portable handset. However, the Examiner admitted that:

"Withnall et al fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the coded signal." (January 3, 2003 Office Action Summary, p. 5, paragraph 5).

The Examiner contended that Fields teaches these features by disclosing a microcontroller accessing means 20 that includes a "barcode electronic circuit" coupled to a barcode reader, wherein the microcontroller accesses and transmits programming material in response to receiving a coded signal. The Examiner argued that the system disclosed in Fields displays "video/image/programming/

sound/pictorial/electronic/media data" on a "television/workbook."

The Examiner stated that combining the systems disclosed in Withnall and Fields would have been obvious at 5 the time of Applicants' invention:

"in order to provide Withnall et al with a higher technology system wherein the user being provided with a full complete information [sic] in a flexible ways [sic] ... Furthermore, such 10 modification would have been an obvious extension as taught by Withnall et al." (January 3, 2003 Office Action Summary, p. 5, paragraph 5).

Also, the Examiner rejected claims 179, 180, 185, 186, 188, 194, 195, 197, 198, and 219-224 under 35 U.S.C. § 15 103(a) as being unpatentable over Withnall as modified by Fields "as applied to claim[s] 168 and 301" in view of Roberts U.S. Patent No. 5,324,922 (hereinafter referred to as "Roberts") and Malec et al. U.S. Patent No. 5,287,266 (hereinafter referred to as "Malec"). The Examiner 20 admitted that Withnall and Fields fail to teach online or home shopping and a cable television data link, and argued that these features are disclosed by Roberts. According to the Examiner, the combination of Roberts with Withnall and Fields would have been obvious and would provide:

"a faster system due to the benefit of cable television transmitting capability. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields to provide the user an alternative way of doing shopping." (January 3, 2003 Office Action Summary, p. 6, paragraph 6).

Moreover, the Examiner admitted that Withnall, Fields, and Roberts all fail to disclose an Integrated Services Digital Network ("ISDN") data link which, according to the Examiner, is disclosed by Malec. In the opinion of the Examiner, the combination of Malec with Withnall, Fields, and Roberts would have been obvious for providing:

"a more accurate and faster system due to the benefit of ISDN networking line[s]. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Roberts and would have merely been a substitution of equivalents." (January 3, 2003 Office Action Summary, pp. 6-7, paragraph 6).

Next, the Examiner rejected claims 184, 187, 191-193, 196, 199, 204-206, 208-209, 214-215, 218, 226-271, 279, 284, 286-288, 299, and 302 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields "as

applied to claim[s] 168 and 301" in view of Bravman et al. U.S. Patent No. 5,401,944 (hereinafter referred to as "Bravman"). The Examiner admitted that Withnall and Fields fail to teach displaying information comprising specific, 5 travel-related details on a wireless communication device. According to the Examiner, Bravman teaches a remote unit providing travel-related information, and the combination of Withnall, Fields, and Bravman would have been obvious for providing:

10 "a more flexibility [sic] system wherein the system is capable of providing the user all of his/her desired information about the trip/vacation that he/she is about to take, and thus providing a more user-friendly system.

15 Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields." (January 3, 2003 Office Action Summary, pp. 7-8, paragraph 7).

Also, the Examiner rejected claims 202, 207, and 210 under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields "as applied to claim[s] 168 and 301" in view of Waterbury German Patent No. DT 24 52 202 A1 (hereinafter referred to as "Waterbury"). The Examiner admitted that Withnall and Fields fail to teach an

invisible machine recognizable feature, which is argued to be taught by Waterbury. The Examiner asserted that the combination of Waterbury with Withnall and Fields would have been obvious for providing:

5 "a more secure system wherein the data recorded in the machine recognizable feature is invisible to [the] naked eye, thus preventing manipulating [sic] by [a] fraudulent user. Furthermore, such modification would have been an obvious extension
10 as taught by Withnall et al/Fields." (January 3, 2003 Office Action Summary, p. 8, paragraph 8).

Next, the Examiner rejected claims 203 and 217 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields "as applied to claim[s] 168 and 301" in view of Tannehill et al. U.S. Patent No. 5,158,310 (hereinafter referred to as "Tannehill"). The Examiner admitted that Withnall and Fields fail to teach a magnetic code strip, which is argued to be taught by Tannehill. According to the Examiner, the aforementioned combination would have been obvious for providing Withnall and Fields with an alternative method for encoding data. "Furthermore, such modification would have mere[ly] been a substitution of equivalents." (January 3, 2003 Office Action Summary, p. 9, paragraph 9).

Additionally, the Examiner rejected claims 211-213, and 216 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields "as applied to claim[s] 168 and 301" in view of Schach *et al.* U.S. Patent No. 5,397,156 (hereinafter referred to as "Schach") and Waterbury. The Examiner admitted that Withnall and Fields fail to teach a watermark, which is argued to be taught by Schach. In the Examiner's opinion, the combination of Schach with "Withnall et al/Fields aesthetic purpose" would have been obvious. "[S]uch modification would have been an obvious extension as taught by Withnall et al/Fields." (January 3, 2003 Office Action Summary, p. 9, paragraph 10).

The Examiner then admitted that Withnall, Fields, and Schach fail to teach an invisible watermark, which is argued to be taught by Waterbury. The Examiner asserted that the combination of Withnall, Fields, Schach, and Waterbury would have been obvious for providing:

"a more secure system wherein the data recorded in the machine recognizable feature is invisible to [the] naked eye, thus preventing manipulating [sic] by [a] fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Schach et al."

(January 3, 2003 Office Action Summary, p. 10,
paragraph 10).

Also, the Examiner rejected claims 190, 276-278, 283,
284, 289-295, 297, 298, and 300 under 35 U.S.C. § 103(a) as
5 being unpatentable over Withnall as modified by Fields "as
applied to claim[s] 168 and 301" in view of Morales U.S.
Patent No. 5,872,589 (hereinafter referred to as
"Morales"). The Examiner admitted that Withnall and Fields
fail to teach a display unit comprising a "personal
10 planner/phone/pager," which is argued to be taught by
Morales. In the Examiner's opinion, combining Withnall,
Fields, and Morales would have been obvious to provide:

"the user with the flexibility of selecting
his/her desired display unit that is fitting
15 his/her needs, thus providing a more user-
friendly system. Furthermore, such modification
would have been an obvious extension as taught by
Withnall et al/Fields." (January 3, 2003 Office
Action Summary, pp. 10-11, paragraph 11).

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III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

A. DOUBLE PATENTING

The Examiner rejected claims 168, 301, and 304 under
the judicially created doctrine of obviousness-type double

patenting as being unpatentable over claim 1 of the '863 patent. In response, Applicants are filing a Terminal Disclaimer with this Amendment to overcome the Examiner's double patenting rejection.

5 B. 35 U.S.C. § 103

The Examiner rejected claims 168-178, 181-183, 200-201, 225, 272-275, 280-282, 285, 296, 301, and 303-306 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Fields. Applicants respectfully disagree and submit that none of the aforementioned claims are obvious in view of Withnall and Fields. In order for a claimed invention to be obvious in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. (see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)) (see Manual of Patent Examining Procedure §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or motivation to modify or combine Withnall with Fields exists.

5 "Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital
10 Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original).

The Examiner contended that it would be obvious to
15 combine the teachings of Withnall with Fields to arrive at the various embodiments of Applicants' invention. Yet, the Examiner has cited only purported benefits of this combination without pointing to what motivation is provided by the references themselves. Applicants submit that none
20 of these combinations would have been obvious to one of skill in the art at the time of Applicants' invention. Specifically, Withnall discloses a system for easing the examination of commuter tickets for validity. This purpose is far removed from the intent of the training system disclosed by Fields. The training system of Fields is used
25 to provide a user with audio/visual output from a videodisc player coinciding with material presented in a training manual. The differing purposes of these two references have no overlap in use, and therefore, would not provide
30 one skilled in the art with a motivation or suggestion to

combine these references. Thus, an inventive step must be performed for one skilled in the art to arrive at the idea of combining any features of Withnall with Fields.

Upon reconsideration, the Examiner will undoubtedly
5 recognize that the reasons put forth for the § 103(a) rejection actually support an "obvious to try" argument. Of course, "obvious to try" is not the standard for obviousness under 35 U.S.C. § 103." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir.
10 1986).

Under these circumstances, we respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed.
15 Cir. 1983):

"It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in
20 a court of law."

Applicants submit that the only suggestion or
25 motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No such suggestion or motivation is provided by the references

themselves; nor could there be in view of the difference in subject matter and the corresponding goals thereof.

In addition to the lack of suggestion or motivation to combine Withnall and Fields, there is no expectation of success for the combination of these references, and any possible resulting device would not teach or suggest all of the claim limitations. Withnall discloses a machine capable of scanning a bar code on a commuter ticket and subsequently displaying the validity of the ticket based on information stored in a memory means. Fields discloses a system reading a bar code on a training manual for playing corresponding material from a videodisc. Consequently, there is no reasonable expectation of success in combining Withnall and Fields. Applicants respectfully submit that the combination of Withnall and Fields cannot disclose the dynamic programming material of the claimed invention. Claims 168, 301, and 304 all disclose the accessing of programming material. The programming material of the present invention is designed such that it can be altered or updated at any time. As a result, upon scanning a ticket, a traveler will be provided with the most recently updated version of the associated information (or programming material). This is not possible with the combination of Withnall and Fields. Specifically, the

combination would entail a videodisc player located on, for example, a bus. Therefore, anytime information must be changed, a new videodisc must be inserted into the videodisc player. This is not feasible, especially because

5 the validity of a ticket can change each time a ticket is used and could require a new videodisc to be employed every time a ticket is used. Moreover, the radio data link of Withnall cannot be utilized to access a remote videodisc player for obtaining audio/visual material because the

10 radio data link is designed only for transmitting a validity state and not substantially different audio/visual material. In particular, audio/visual material requires substantially more data to be transmitted in a specialized format. Thus, a system for achieving such transmission

15 would need to be invented and implemented for remotely accessing a videodisc player. Therefore, any attempt to combine Withnall and Fields to create the present invention would be unsuccessful and fail to provide the flexible, updateable system of the claimed invention. Moreover, the

20 programming material of the claimed invention is not disclosed by the combination of these references.

In view of the foregoing, claims 168, 301, and 304 cannot be unpatentable over Withnall and Fields. The remaining rejected claims are dependent on these claims and

contain all of the limitations of their respective base claims. Therefore, these claims are also not unpatentable over these references.

In all subsequent rejections, the Examiner noted the 5 deficiencies of the Withnall and Fields combination regarding matter disclosed in dependent claims and appended various other references including Roberts, Malec, Bravman, Waterbury, Tannehill, Schach, and Morales to the combination in order to provide the additional features of 10 the dependent claims. However, the combination of Withnall and Fields has been shown to be not only improper, but also to lack the disclosure of each and every element of the base claims. Because this combination is improper and incomplete, any further combining of references to Withnall 15 and Fields would also be improper. Thus, Applicants respectfully submit that all remaining rejections have also been overcome and should be withdrawn.

CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and
5 favorable action is accordingly solicited.

Respectfully submitted,

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